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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rolf STEIGER

Serial No.: 09/336,462

Filed: June 18, 1999

Group Art Unit: 1774

Examiner: M. Grondzynska

Date: April 26, 2001

For: RECORDING SHEETS FOR INK JET PRINTING

Assistant Commissioner for Patents
Washington, D.C. 20231RESPONSE TO ELECTION REQUIREMENT

Sir:

This is responsive to the Office Action dated March 28, 2001, in the above-identified application.

The Examiner has required that an election of invention be made between the following invention Groups: the recording sheet of Group I (Claims 1-9 and 11-20) and the coating composition of Group II (Claim 10). Applicants hereby elect the invention of Group I (Claims 1-9 and 11-20) with traverse. The election requirement is traversed for the following reasons.

The Examiner asserts that the inventions of Groups I and II are distinct, as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate-final product is useful to make other than the final product. The Examiner states that "there is a compositional difference between the inventions of I and II, namely that there would be no solvent present in the article of invention I and as such the intermediate product is deemed to be useful as an anti-slip coating." Applicants submit that this assertion is in error.

The ink receiving layers according to the invention are in general coated from aqueous solutions or dispersions containing all the necessary ingredients. Page 9 line 26 on, describes how the coatings of the recording sheets according to the invention were prepared and the Examples describe the components of the coating compositions. The ink receiving layers on the recording

sheet as defined in claim 1 are the coating compositions of claim 10 (Group II).

In view of such, Applicant is unclear about Examiner's assertion that the coating composition of claim 10 is an "intermediate product" and is "deemed useful" as an anti-slip coating when it would also appear that as an anti-slip coating - after drying - there would also be no solvent present and as such the materials would be the same.

The Manual of Patent Examining Procedure provides that restriction between patentably distinct inventions is proper when (1) the inventions are independent or distinct as claimed, and (2) unrestricted examination would seriously burden the Examiner. See MPEP 803. Neither criteria is met in the present case. It is believed that the fields of search for the recording sheet and composition claims of the invention overlap and that Patent efficiencies will be furthered by unrestricted examination of the application.

For the foregoing reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement.

Respectfully submitted,

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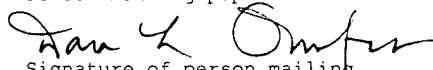
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